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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------|-------------|----------------------|---------------------|------------------|
| 10/003,882        | 10/25/2001  | Kevin W. Kelly       | 9911.1 CIP Kelly    | 8231             |
| 25547             | 7590        | 08/11/2004           |                     |                  |
| EXAMINER          |             |                      |                     |                  |
| FLANIGAN, ALLEN J |             |                      |                     |                  |
| ART UNIT          |             | PAPER NUMBER         |                     |                  |
|                   |             | 3753                 |                     |                  |

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 10/003,882      | KELLY ET AL. |
| Examiner                     | Art Unit        |              |
| Allen J. Flanigan            | 3753            |              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 May 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 16-21,25 and 36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 16-21,25 and 36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

The examiner objects to the blanket statements on page 22 incorporating numerous cited non-US patent disclosures by reference into the specification. As pointed out in the previous office action, the incorporation by reference to a non-US patent document of essential subject matter in a patent application at the time of publication is not permitted. MPEP § 608.01(p).

Applicants have responded to the examiner's objections by alleging that the incorporated material is "nonessential subject matter". MPEP 608.01(p) defines "nonessential subject matter" as "subject matter referred to for purposes of indicating the background of the invention, or illustrating the state of the art." Yet most of the citations are contained not in the background discussion on pages 1-3 of the specification, but in the section of the specification dealing with the detailed description of the invention (pps. 4-22). None of these references are expressly identified as being incorporated solely for the purpose of illustrating the state of the art. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112)", and any material contained in the specification of a patent disclosure which does not constitute background information presumably constitutes essential material. Indeed, 37 C.F.R. 1.71 stipulates that this essential material is what the specification must contain:

The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery pertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth."

Further, it is noted that applicants in their response indicate the rationale for retaining the incorporated references is "to avoid . . . the omission of [material] essential to support the claims" (pps. 3-4 of the response). While the inadvertent omission applicant refers to is an understandable risk of prompt filing, applicants have had ample time to review the disclosure and add any and all material from the incorporated references necessary to support the claimed invention.

If the material on pages 4-22 of the specification (including the incorporated reference material cited therein) is not "essential" material as defined above, why has it been included in the specification? Any matter which is not necessary to an understanding of the invention either for the purposes of

disclosure (complying with the requirements of 35 U.S.C. 112) or for background purposes would be considered extraneous matter which does not belong in a patent disclosure. MPEP §1302.01.

The “incorporation by reference” practice (applied to foreign patent documents or other documents not readily available to the public) does indeed give applicants recourse to correct inadvertent omissions made at the time of filing. Hence the requirement to amend the disclosure to include the material so incorporated, so that, at the time of publication, the patent disclosure is ensured of being reasonably complete. MPEP § 608.01(p). Permitting patent disclosures to issue with such incorporations by reference present therein would defeat the goal of “minimiz[ing] the public’s burden to search for and obtain copies of documents incorporated by reference which may not be readily available,” and invite the abuse which the CCPA expressly referred to in ***In re Hawkins, 486 F.2d 577, 179 USPQ 167.***

The applicant is therefore required to either delete the incorporations by reference on page 22 of the specification, or if the material is truly background information, amend the disclosure to incorporate it in the appropriate section at the beginning of the disclosure, and clearly indicate that the material incorporated is for background purposes and does not form an essential part of the disclosure. If the material is neither background nor essential for completeness, it should be deleted as extraneous matter.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16-21 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schubert et al.

Please see the comments made in regard to the above rejection in the previous Office action.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schubert et al. in view of Hoopman et al.

Please see the comments made in regard to the above rejection in the previous Office action.

Applicant's arguments filed 5/27/2004 have been fully considered but they are not persuasive.

The objection to the specification for improper incorporation by reference has been addressed above. Regarding the rejection based on prior art, the applicant's comments are not commensurate in scope with the claims. Claim 16 does not recite "wherein the direction of flow of said first fluid channels is generally perpendicular to the *plane* of said second fluid channels" (emphasis added), but rather "perpendicular to the direction of flow of said second fluid channels", which, as pointed out above, is a limitation Schubert et al. clearly meets.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Flanigan whose telephone number is (703) 308-1015. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on (703) 308-1272. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Allen J. Flanigan  
Primary Examiner  
Art Unit 3753

AJF